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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,141	09/18/2003	Kenneth A. Gan	90839.000002	8211
23387	7590	01/29/2007		
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			EXAMINER TRAN, TUYETLIEN T	
			ART UNIT	PAPER NUMBER
			2179	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/666,141

Applicant(s)

GAN, KENNETH A.

Examiner

TuyetLien (Lien) T. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/19/03, 3/25/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 11 and 13 are objected to because of the following informalities: "one the first terminal and the second terminal" should be changed to "one of the first terminal and the second terminal". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al (Patent No 5740245, hereinafter Bennett).

*As to claim 1*, Bennett teaches:

A communication system for providing face-to-face interactive real time text messaging (e.g., see Fig. 1), the system comprising:

(a) a first and a second terminal (e.g., an associate examining attorney's terminal 17 and an attorney's terminals 15, see Fig. 1), each terminal having a keyboard for entering text and a display for displaying entered and received text (e.g., see Fig. 8 Fig. 6b), each terminal configured to transmit and receive text from the other terminal (e.g.,

terminal 15 and 17 provide a vehicle for the examining and associate examining attorneys to exchange messages, see col. 8 lines 58-64 and Fig. 6b), the first terminal configured to delete text received and displayed by the second terminal (e.g., the associate's terminal 17 provides the capability of modifying the communication currently present on the attorney terminal 15, see col. 23 lines 1-6); and

(b) a communication link between the first terminal and the second terminal (e.g., communication link 23 as shown in Fig. 1), the communication link configured to enable communication between the first and the second terminal in a face to face position and preclude communication beyond a face to face position (e.g., see Fig. 1 items 15, 17 and 23).

*As to claim 4*, Bennett teaches:

A method providing two way interactive text messaging (e.g., see Fig. 1), the method comprising:

(a) locating a first and a second terminal in a face to face position (e.g., an associate examining attorney's terminal 17 and an attorney's terminals 15, see Fig. 1);

(b) keying text into the first terminal (e.g., see Fig. 8 and col. 22 lines 50-67);

(c) displaying the keyed text at the first terminal (e.g., window 307 provides for input and display of messages, notes, etc, see Fig. 8 and col. 22 lines 50-67);

(d) transmitting the displayed text from the first terminal to the second terminal (e.g., see col. 8 lines 58-64 and col. 22 lines 50-67);

(e) displaying the transmitted text at the second terminal in conjunction with a first terminal identifier (e.g., see Fig. 6b); and

(f) deleting displayed text at the second terminal in response to a command from the first terminal (e.g., the associate's terminal 17 provides the capability of modifying the communication currently present on the attorney terminal 15, see col. 23 lines 1-6).

*As to claim 14*, Bennett teaches:

A communication system for providing face-to-face interactive real time text messaging (e.g., see Fig. 1), the system comprising:

(a) a first and a second terminal (e.g., an associate examining attorney's terminal 17 and an attorney's terminals 15, see Fig. 1), each terminal having a keyboard for entering text and a display for displaying entered and received text (e.g., see Fig. 8 Fig. 6b), each terminal configured to transmit and receive text from the other terminal (e.g., terminal 15 and 17 provide a vehicle for the examining and associate examining attorneys to exchange messages, see col. 8 lines 58-64 and Fig. 6b), each terminal including translating programming for translating entered text from a first language to a different second language (e.g., see col. 16 lines 1-10); and

(b) a communication link between the first terminal and the second terminal (e.g., communication link 23 as shown in Fig. 1), the communication link configured to enable communication between the first and the second terminal in a face to face position and preclude communication beyond a face to face position (e.g., communication link 23 as shown in Fig. 1).

*As to claim 2*, Bennett further teaches wherein the first and the second terminals are configured to precede each displayed line of text with an identifier of the sending terminal (e.g., see Fig. 6b).

*As to claim 3*, Bennett teaches wherein the communication link includes a cable having a length to place the first and second terminals in the face-to-face position (e.g., see Fig. 1 items 15, 17 and 23).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett.

*As to claim 5*, Bennett teaches:

A method providing two way interactive text messaging (e.g., see Fig. 1), the method comprising:

(a) locating a first and a second terminal in a face to face position (e.g., an associate examining attorney's terminal 17 and an attorney's terminals 15, see Fig. 1);

(b) selecting one of a first set of predefined messages in the first terminal (e.g., selects the desired communication from the stack of messages, see col. 19 lines 58-65;

note that the functionality of communications in terminal 17 and terminal 15 are identical, see e.g., col. 22 lines 64-65 to col. 23 lines 1-6);

(c) displaying the selected text at the first terminal (e.g., window 307 provides for input and display of messages, notes, etc, see col. 22 lines 50-63 and Fig. 8);

(d) transmitting the displayed text from the first terminal (e.g., terminal 17) to the second terminal (e.g., communications can be communicated to other terminal, see col. 19 lines 41-65; note that the functionality of communication in terminal 17 and terminal 15 are identical, see e.g., col. 22 lines 64-65 to col. 23 lines 1-6);

(e) displaying the transmitted text at the second terminal (terminal 15) in conjunction with a first terminal identifier (e.g., see Fig. 6b); and

(f) selecting one of a different second set of predefined messages in the second terminal (e.g., in terminal 15, selects the desired communication from the stack of messages, see col. 19 lines 58-65).

Bennett further teaches pressing a "number" key 278 "#" followed by the number previously associated with a specific Q & A, a terminal locates and display that Q & A in a display window (e.g., see col. 18 lines 37-45 and Fig. 6b). Bennett does not expressly teach that pressing a shortcut key to select a predefined message to be transmitted.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented the shortcut key function to allow a user to select a predefined message in a communication window, in view of Bennett, because Bennett suggests to the skilled artisan that shortcut keys are used to cause a display window to display the desired message (e.g., see col. 17, lines 62-67 to col. 18

lines 1-54). The motivation would be to allow a user to quickly access or select desired message or communication with less interaction than the usual method.

*As to claim 6*, Bennett teaches the limitation of claim 5 for the reasons as discussed above. Bennett further teaches editing the selected message at the first terminal prior to transmitting to the second terminal (e.g., in terminal 17, communications can be created, modified, deleted, printed, or communicated to the other terminal; note that the functionality of communications to and from terminal 17 and terminal 15 are identical, see e.g., col. 19 lines 41-65 and col. 22 lines 64-65 to col. 23 lines 1-6). Thus, Bennett's teaching would meet the claim limitation for the same reasons as discussed with respect to claim 5 above.

*As to claim 7*, Bennett teaches the limitation of claim 5 for the reasons as discussed above. Bennett further teaches deleting, in response to a command from the first terminal, all previously transmitted and received messages between the first and the second terminal (e.g., the associate's terminal 17 provides the capability of modifying the communication currently present on the attorney terminal 15, see col. 23 lines 1-6). Thus, Bennett's teaching would meet the claim limitation for the same reasons as discussed with respect to claim 5 above.

*As to claim 8*, Bennett teaches the limitation of claim 5 for the reasons as discussed above. Bennett further teaches printing the previously transmitted and received messages between the first and the second terminal to include a signature line (e.g., communications can also be printed, see col. 19 lines 41-67). Thus, Bennett's



teaching would meet the claim limitation for the same reasons as discussed with respect to claim 5 above.

6. Claims 9-10, 12, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Kawanaka (Patent No 6138145, hereinafter Kawanaka).

*As to claim 10*, Bennett teaches:

A face-to-face text communication system (e.g., see Fig. 1) comprising:

(a) a first terminal having a first keyboard and a first display (e.g., an associate examining attorney's terminal 17, see Fig. 1);

(b) a second terminal having a second keyboard and a second display (e.g., an attorney's terminals 15, see Fig. 1), both the first terminal and the second terminal configured to transmit and receive text from and to each other (e.g., terminal 15 and 17 provide a vehicle for the examining and associate examining attorneys to exchange messages, see col. 8 lines 58-64 and Fig. 6b), the first terminal configured to invoke a predetermined display on the second terminal (e.g., the associate's terminal 17 provides the capability of modifying and sorting the communication currently present on the attorney terminal 15, see col. 23 lines 1-6).

Bennett does not expressly teach that the first terminal can invoke a display on the second terminal without displaying the display on the first terminal.

Kawanaka teaches the first terminal (e.g., supporting-side computer 1, see col. 4 lines 1-11 and Fig. 2) configured to invoke a predetermined display (e.g., see items 32-

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39 in Fig. 10) on the second terminal (e.g., supported-side computer 2, see col. 4 lines 1-11 and Fig. 3) without displaying the predetermined display on the first terminal (e.g., see Fig. 9 and Fig. 10).

Bennett and Kawanaka are analogous art because they are from the same field of endeavor of providing communication between two computers. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented the feature the first terminal can invoke a display on the second terminal without displaying the display on the first terminal as taught by Kawanaka to the real-time communication system as taught by Bennett to make it possible to carry out a real-time electronic dialog relative to a computer operated even by an operator unfamiliar with keyboard manipulation and to allow the electronic dialog between the computers to be performed easily and widely (e.g., see Kawanaka col. 7 lines 1-14)

*As to claim 12*, Bennett teaches:

A face-to-face text communication system (e.g., see Fig. 1) comprising:

(a) a first terminal having a first keyboard and a first display (e.g., an associate examining attorney's terminal 17, see Fig. 1);

(b) a computer having a second keyboard and a second display (e.g., an attorney's terminals 15, see Fig. 1), both the first terminal and computer configured to transmit and receive text from and to each other (e.g., terminal 15 and 17 provide a vehicle for the examining and associate examining attorneys to exchange messages, see col. 8 lines 58-64 and Fig. 6b), the first terminal configured to invoke a predetermined display on the computer (e.g., the associate's terminal 17 provides the

capability of modifying and sorting the communication currently present on the attorney terminal 15, see col. 23 lines 1-6).

Bennett does not expressly teach that the first terminal can invoke a display on the computer without displaying the display on the first terminal.

Kawanaka teaches the first terminal (e.g., supporting-side computer 1, see col. 4 lines 1-11 and Fig. 2) configured to invoke a predetermined display (e.g., see items 32-39 in Fig. 10) on the computer (e.g., supported-side computer 2, see col. 4 lines 1-11 and Fig. 3) without displaying the predetermined display on the first terminal (e.g., see Fig. 9 and Fig. 10). Thus, combining Bennett's teaching with Kawanaka's teaching would meet the claimed limitation for the same reason as discussed with respect to claim 10 above.

*As to claims 9 and 15*, Bennett teaches the limitation of claims 5 and 14 for the reasons as discussed with respect to claims 5 and 14 above. Bennett does not expressly teach that displaying a predetermined message from the first terminal only on the second terminal. Kawanaka teaches displaying a predetermined message from the first terminal only on the second terminal in response to a command at the first terminal (e.g., see Fig. 9 and Fig. 10). Thus, combining Bennett's teaching with Kawanaka's teaching would meet the claimed limitation for the same reason as discussed with respect to claim 10 above.

7. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Kawanaka further in view of Hamilton (Patent No 5176520, hereinafter Hamilton).

*As to claims 11 and 13*, Bennett and Kawanaka teach the limitation of claim 10 and 12 for the reasons as discussed with respect to claims 10 and 12 above. Bennett further teaches wherein the first terminal is configured to delete text received at the second terminal or computer (e.g., the associate's terminal 17 provides the capability of modifying the communication currently present on the attorney terminal 15, see col. 23 lines 1-6).

Bennett does not teach that the second terminal or computer is configured to delete text received at the remaining terminal. Hamilton teaches a computer assisted instructional delivery system that enable both teacher and student while in eraser mode allow a small rectangle of blank space to "white out" anything that is at the position (see col. 3 lines 31-38 and col. 13 lines 42-66).

Bennett, Kawanaka, and Hamilton are analogous art because they are from the same field of endeavor of two-way communication system that transmit and receiver information from a computer or terminal to another. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have implemented the deleting function in second terminal as well to provide the ability of simultaneously written interactions between users (e.g., see Hamilton col. 1 lines 55-58).

*Conclusion*

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action.

*Examiner's note:* Examiner has cited particular columns, line numbers, and figures in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teaching of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TuyetLien (Lien) T. Tran whose telephone number is 571-270-1033. The examiner can normally be reached on Mon-Friday: 7:30 - 5:00, off on alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Lien Tran  
Examiner  
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**WEILUN LO**  
**SUPERVISORY PATENT EXAMINER**